

REMARKS

Applicants have received the Office Action dated August 6, 2008 in which the Examiner: **1)** rejected Claims 1-9 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter; **2)** rejected Claims 1, 2, 10, 16 and 18 under 35 U.S.C. §103(a) as allegedly obvious over "Bruno et al.", U.S. Patent No. 5,774,459 (hereinafter *Charrat*; please see comments under the "Initial Remark" section below) in view of Sashihara et al., U.S. Patent Publication No. 2003/0189948 (hereinafter *Sashihara*); **3)** rejected Claims 3-5, 11, 12, 17 and 19 as allegedly obvious over *Charrat* in view of *Sashihara* and in further view of Terry et al., U.S. Patent No. 7,046,651 (hereinafter *Terry*); **4)** rejected Claims 6 and 13 as allegedly obvious over *Charrat* in view of *Sashihara*, in further view of *Terry*, and in further view of Luna-Aceves et al., U.S. Patent No. 6,996,074 (hereinafter *Luna-Aceves*); and **5)** allowed Claims 7-9, 14, 15 and 20.

Claims 1-20 remain pending in the present Application. Based on the remarks herein, Applicants respectfully submit that all pending claims are in condition for allowance.

Initial Remark

Applicants respectfully observe that the reference (U.S. Patent No. 5,774,459) recited by the Examiner as "Bruno et al" and "Bruno" within the present Office Action should more properly be referred to as "Charrat". In deference to the individual who, according to the cover sheet for U.S. Patent No. 5,774,459, is the sole inventor, namely, Bruno Charrat, Applicants will respond to the Examiner's comments directed toward the "Bruno et al" or "Bruno" reference hereinafter by referring to "*Charrat*".

Applicants hereby respectfully request the Examiner correct the U.S. Patent Office files with respect to the present Application so that any future reference accurately identifies U.S. Patent No. 5,774,459 to Charrat.

Claim Rejection under 35 U.S.C. § 101 – Claims 1-9

The Examiner has rejected Claims 1-9 under 35 U.S.C. § 101 due to claim informalities. Applicants respectfully traverse this rejection.

Applicants respectfully decline to amend their claims. First, the claims contain physical elements, and therefore are statutory. Second, numerous patents have already been issued containing granted claims which begin by reciting “An arrangement for...”; see for example, U.S. Patent No. 7,437,756 which was granted as recently as October 14, 2008.

For at least these reasons, Applicants respectfully request this rejection to Claims 1-9 be withdrawn.

Claim Rejection under 35 U.S.C. § 103(a) – Claims 1, 2, 10, 16 and 18

The Examiner has rejected Claims 1, 2, 10, 16 and 18 under 35 U.S.C. § 103(a) as allegedly obvious over *Charrat* in view of *Sashihara*. Applicants respectfully traverse this rejection.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (B.P.A.I. 1979). In establishing a *prima facie* case for obviousness, it is often necessary “to look to interrelated teachings of multiple patents, the effects of demands known to the design community or present in the market place; and the background knowledge possessed by a person having ordinary skill in the art.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. ___, 127 S.Ct. 1727, 82 USPQ2d 1385, 1396 (2007)(Slip Opinion No. 04-1350 (U.S. April 30, 2007) at 14). Indeed, “the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined.” *Id.* slip opinion at 2 (quoting *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966)). This analysis should be made explicitly. *Id.* slip opinion at 14 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory

statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

Additionally, a claim having several elements is *not* proved obvious merely by demonstrating that each of its elements was known in the prior art. *Id.* As such, the obviousness inquiry does not hinge on demonstrating that elements were known in the art. Rather, the obviousness inquiry focuses on whether the claimed subject matter would have been obvious to persons having ordinary skill in the art in view of the demands and practices of the design community at the time of filing of the application. See *id.*

Moreover, the Applicants submit that, during the patent examination, the pending claims must be given an interpretation that is reasonable and consistent with the specification. See *In re Prate*, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969); *In re Morris*, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997); see also M.P.E.P. §2111 (describing the standards for claim interpretation during prosecution). Indeed, the *specification* is “the primary basis for construing the claims.” *Philips v AWH Corp.*, 415 F.3d 1303, 1315 (Fed.Cir. 2005). It is usually dispositive. See *id.* Interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. See *In re Cortright*, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); see also M.P.E.P. §2111. That is, recitations of a claim must be read as they would be interpreted by those of ordinary skill in the art. See *Rexnord Corp. v. Laliram Corp.*, 60 U.S.P.Q.2d 1851, 1854 (Fed. Cir. 2001); see also M.P.E.P. §2111.01. In summary, an Examiner, during prosecution, must interpret a claim recitation as one of ordinary skill in the art would reasonably interpret the claim in view of the specification. See *In re American Academy of Science Tech Center*, 70 U.S.P.Q.2d 1827 (Fed. Cir. 2004).

Independent Claim 1 recites, “[a]n arrangement for avoiding contention on a communication medium among devices including at least a transmitter and a receiver, the arrangement comprising:

a first portion configured to instruct the receiver to indicate that the communication medium is busy for a time period substantially longer than

an actual frame transmission period being sent from the transmitter to the receiver; and

a second portion configured to prohibit the receiver from transmitting on the communication medium during the time period.”

Independent Claim 10 recites, “[a] method for avoiding contention on a communication medium by devices including at least a transmitter and a receiver, the method comprising:

instructing a receiver to indicate that the communication medium is busy for a time period substantially longer than a frame being sent from the transmitter to the receiver; and

prohibiting the receiver from transmitting on the communication medium during the time period.”

Independent Claim 16 recites, “[a] network including a communication medium on which contention is to be avoided, the network comprising:

a transmitting element, configured to transmit on the communication medium, a frame that includes an instruction that the communication medium is busy for a time period substantially longer than an actual transmission time of the frame that includes the instruction; and

a receiving element, configured to receive the frame that includes the instruction, and, in response to the instruction, to refrain from transmitting on the communication medium during the time period, so as to avoid the contention on the communication medium.”

Although the “primary” reference *Charrat* is missing further claim limitations and element relationships, Applicants agree with the Examiner that *Charrat* also fails to teach or suggest “...a first portion configured to instruct the receiver...”, much less “...a first portion configured to instruct the receiver to indicate that the communication

medium is busy for a time period substantially longer than an actual frame transmission period being sent from the transmitter to the receiver..." (Claim 1). Applicants also agree with the Examiner that "primary" reference *Charrat* fails to teach or suggest "...instructing a receiver to indicate...", much less "...instructing a receiver to indicate that the communication medium is busy for a time period substantially longer than a frame being sent from the transmitter to the receiver..." (Claim 10). Applicants further agree with the Examiner that "primary" reference *Charrat* fails to teach or suggest "...a frame that includes an instruction...", much less "a frame that includes an instruction that the communication medium is busy for a time period substantially longer than an actual transmission time of the frame that includes the instruction...", and much less "a transmitting element, configured to transmit on the communication medium, a frame that includes an instruction that the communication medium is busy for a time period substantially longer than an actual transmission time of the frame that includes the instruction..." (Claim 16). *Sashihara* is cited to purportedly meet all of these missing limitations. Unfortunately, the Examiner has failed to make a *prima facie* case for obviousness.

At least one reason: as is the case with *Charrat*, *Sashihara* also fails to teach or suggest, among other missing limitations "...a first portion configured to instruct the receiver...", much less "...a first portion configured to instruct the receiver to indicate that the communication medium is busy for a time period substantially longer than an actual frame transmission period being sent from the transmitter to the receiver..." (Claim 1), or "...instructing a receiver to indicate...", much less "...instructing a receiver to indicate that the communication medium is busy for a time period substantially longer than a frame being sent from the transmitter to the receiver..." (Claim 10), or "...a frame that includes an instruction...", much less "a frame that includes an instruction that the communication medium is busy for a time period substantially longer than an actual transmission time of the frame that includes the instruction...", and much less "a transmitting element, configured to transmit on the communication medium, a frame that includes an instruction

that the communication medium is busy for a time period substantially longer than an actual transmission time of the frame that includes the instruction..." (Claim 16).

Specifically, the Examiner kindly points to page 4, paragraph [0099] and page 5, paragraph [0120] of *Sashihara*, which portions are set forth in full herein, as follows:

"[0099] The packet transmitter 504 asks the packet receive section 502 about higher rank state (idle line/inhibit), and, in the case of an idle state, sends the packet, sent from the hop count addition section 504, through the radio section 501 and, at the same time, stores the sent packet in the send buffer 505."

"[0120] The backoff time decision section 408 calculates the backoff time based on the notice of the random number and the result of the examination of the priority level of the packet (step S714), and informs the packet transmitter 405 of the determined backoff time."

(emphasis added)

In paragraph [0099] of *Sashihara*, the transmitter "asks" (inquires of) the packet receive section, and the transmitter sends the packet apparently depending upon the packet receive section's response, i.e., no instructing the receiver; while in paragraph [0120] of *Sashihara*, the transmitter is informed of the determined backoff time, i.e., again, no instructing the receiver. It is further respectfully observed that in neither paragraph is there any discussion of a frame, much less a reference or suggestion as to any instruction contained in that frame; in fact, the only reference to a frame in the entirety of *Sashihara* appears in paragraph [0004] which reads as follows:

"[0004] Another method is ICMA/PE (idle-signal casting multiple access with partial echo). The idle/occupy of a leading channel has been indicated by idle line/inhibit bit, and the receive/non-receive due to collision has been indicated by collision detection indication bit. By contrast, according to this method, in addition, send data subjected to certain processing is folded back as a partial echo to the trailing collision control bit, and, thus, sending can be confirmed frame by frame."

(emphasis added)

Thus, Applicants respectfully observe that nothing in the applied portions of *Sashihara* – or seemingly anywhere else in that reference – appears to instruct the receiver about anything, much less that the communication medium is busy (Claim 1), or to instruct the

receiver to indicate that the communication medium is busy (Claim 10), or a frame that includes an instruction that the communication medium is busy (Claim 16).

Applicants respectfully observe that the above are only some of the explicitly claimed limitations and element relationships missing from the applied references. The missing claimed limitations and relationships in *Charrat* and *Sashihara*, taken together or individually, are in sharp contrast to Applicants' claimed invention. Thus, independent Claims 1, 10 and 16 are not obvious over *Charrat* in view of *Sashihara*. Accordingly, Applicants respectfully request withdrawal of these rejections under Section 103 and allowance of independent Claims 1, 10 and 16, as well as all claims depending therefrom. Thus, all Claims 1-20 should be indicated as allowed.

Claim Rejection under 35 U.S.C. § 103(a) – Claims 3-6, 11-13, 17 and 19

The Examiner has rejected Claims 3-5, 11, 12, 17 and 19 under 35 U.S.C. § 103(a) as allegedly obvious over *Charrat* in view of *Sashihara* and in further view of *Terry*. The Examiner has further rejected Claims 6 and 13 under 35 U.S.C. § 103(a) as allegedly obvious over *Charrat* in view of *Sashihara*, in further view of *Terry*, and in further view of *Luna-Aceves*. Applicants respectfully traverse these rejections. However, each of Claims 3-5, 11, 12, 17 and 19 is a dependent claim that depends on its respective patentable, independent claim. Further *Terry* and *Luna-Aceves* both fail to satisfy the deficiencies of *Charrat* and *Sashihara* that are described above. Thus, these rejections under 35 U.S.C. § 103(a) are moot. As a result, these rejections should be withdrawn, and Claims 3-6, 11-13, 17 and 19 should be indicated as allowed.

Claims Allowed – Claims 7-9, 14, 15 and 20

Applicants thank the Examiner for indicating that their Claims 7-9, 14, 15 and 20 are allowable. For at least the reasons expressed above, Claims 1-6, 10-13, and 16-19 have been shown to also overcome the cited rejections. In view of the above remarks, Applicants respectfully request that the Examiner indicate that their remaining claims are also allowable.

Thus, Applicants respectfully request that Claims 1-20 be indicated as allowed.

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. In the event that an extension of time is necessary to allow for consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Texas Instruments Incorporated's Deposit Account No. 20-0668 for such fees.

Respectfully submitted,

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